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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Daniel Lee Hamilton

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EXAMINER

SHAIKH, MOHAMMAD Z

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/631,972	Applicant(s) HAMILTON ET AL.	
	Examiner MOHAMMAD Z. SHAIKH	Art Unit 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-15, 18-23, 25, 27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-15, 18-23, 25, 27 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/02/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. The following is a NON-FINAL Office Action in response to the communication received on 02/08/08. Claims 1-4, 7-15, 18-23, 25, 27-28 are now pending in this application.
2. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application AFTER NON-FINAL rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the previous Office Action has been WITHDRAWN pursuant to 37 CFR 1.114. Applicant's submission filed on 01/30/09 has been entered.

Response to Amendments

3. Applicants Amendment has been acknowledged in that: Claims 1-2, 4, 7-11, 12-13, 16, 18-22, 27-28 have been amended; Claims 5-6, 16-17, 24 & 26 have been cancelled; hence such, Claims 1-4, 7-15, 18-23, 25, 27-28 are now pending in this application.

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Claim Rejections- 35 U.S.C § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 7-15, 18-23, 25, 27-28 are being rejected under 35 U.S.C 103(a) as being unpatentable over US 2002/0116331 to Cataline et al, herein Cataline in view of US 2002/0032651 to Embrey.

Regarding claim 1, Cataline discloses a method comprising: receiving, at a payment service provider processor ([0034], [0035], [0037]), a payment request to pay a payee on behalf of a payor, wherein the payment request debits a payor account ([0055]); determining, at the payment service provider processor, a plurality of debit options (claim 3); applicable for debiting the payor account, wherein each debit option is associated with a plurality of processing_factors ([0057], claim 13). However Cataline does not disclose selecting, by the payment service provider processor, at least one processing factor of the plurality of processing factors based on a preference associated with at least one of (i) a consumer service provider associated with the payor, or (ii) the payment service provider. Embrey discloses selecting, by the payment service provider processor, at least one processing factor of the plurality of processing factors based on a preference associated with at least one of (i) a consumer service provider associated with the payor, or (ii) the payment service provider ([0153]). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify

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Cataline's invention to include selecting, by the payment service provider processor, at least one processing factor of the plurality of processing factors based on a preference associated with at least one of (i) a consumer service provider associated with the payor, or (ii) the payment service provider. One of ordinary skill in the art would have been motivated to include selecting, by the payment service provider processor, at least one processing factor of the plurality of processing factors based on a preference associated with at least one of (i) a consumer service provider associated with the payor, or (ii) the payment service provider in order to ensure that the payment service provider is given a choice in how they wish to process the payments. Cataline further discloses evaluating, at the payment service provider processor, each debit option of the plurality of debit options based on the at least one processing factor (claim 12); automatically selecting, at the payment service provider processor, one of the plurality of debit options based, at least in part, on the evaluating ([0055]); determining, at the payment service provider processor, a credit option associated with the selected debit option; and executing, at the payment service provider processor, the payment request using the selected debit option and the credit option (claim 1)

Regarding claim 2, Cataline discloses the method of claim 1. Cataline further discloses , wherein the plurality of debit options includes i) electronically debiting the payor account responsive to determining that funds in at least an amount of the payment request are available in the payor account, ii) electronically debiting the payor account responsive to determining that an entity is available from which to collect funds if funds cannot be collected from the payor in association with effecting the payment

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([0013], [0052]), iii) electronically debiting the payor account responsive to selecting an account to receive an electronic credit associated with the electronic debit, the selected account associated with a payment service provider ([0020]), iv) electronically debiting the payor account responsive to determining that a risk of financial loss to a payment service provider associated with effecting the payment on behalf of the payor is an acceptable risk, the determination based upon information associated with at least one of an amount of the payment and one or more prior payments effected on behalf of the payor ([0050]), v) electronically debiting the payor account responsive to determining that an electronic credit can be initiated by a payment service provider to reverse the electronic debit if funds cannot be collected from the payor in association with the effected payment ([0052]).

Regarding claim 3, Cataline discloses the method of claim 1, wherein each of the debit options is determined based, at least in part, upon at least one of i) the identity of the payee, ii) the identity of the payor, iii) the identity of a financial institution at which the payor account is maintained, iv) the identity of a consumer service provider with which the payor is associated, and v) a type of payment service offered by a payment service provider utilized by the payor ([0055]).

Regarding claim 4, Cataline discloses the method of claim 1. Cataline further discloses wherein executing the payment request using the selected debit options and the credit option includes issuing an electronic funds transfer file via the ACH network ([0042]).

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Regarding claim 7, Cataline discloses the method of claim 1. Cataline further discloses wherein the plurality of debit options is determined based upon the received payment request ([0055]).

Regarding claim 8, Cataline discloses the method of claim 1. Cataline further discloses wherein each of the plurality of debit options is associated with a priority, and wherein evaluating each debit option of the plurality of debit options based on the at least one processing factor comprises a first of the plurality of debit options and a second of the plurality of debit options producing the same result and further comprising: determining, by the payment service provider processor, that the first of the plurality of debit options has a higher associated priority than the second of the plurality of debit options; and wherein automatically selecting one of the plurality of debit options comprises automatically selecting the first of the plurality of debit options based at least in part on determining that the first of the plurality of debit options has a higher associated priority than the second of the plurality of debit options ([0057], [0058]).

Regarding claim 9, Cataline discloses the method of claim 1. Cataline further discloses wherein evaluating each debit option of the plurality of debit options based on the at least one processing factor comprises a first of the plurality of debit options and a second of the plurality of debit options producing the same result and further comprising: determining, by the payment service provider processor, that the first of the plurality of debit options is associated with a shorter time period to complete payment to the payee on behalf of the payor than the second of the plurality of debit options; and wherein automatically selecting one of the plurality of debit options comprises

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automatically selecting the first of the plurality of debit options based at least in part on determining that the first of the plurality of debit options is associated with a shorter time period to complete payment to the payee on behalf of the payor than the second of the plurality of debit options. ([0057])

Claim 10 is being rejected using the same rationale as claim 9.

Regarding claim 11, Cataline discloses the method of claim 1. Cataline further discloses wherein evaluating each debit option of the plurality of debit options based on the at least one processing factor comprises a first of the plurality of debit options and a second of the plurality of debit options producing the same result and further comprising: determining, by the payment service provider processor, that the first of the plurality of debit options is associated with a higher level of protection against financial loss to the payment service provider than the second of the plurality of debit options; and wherein automatically selecting one of the plurality of debit options comprises automatically selecting the first of the plurality of debit options based at least in part on determining that the first of the plurality of debit options is associated with a higher level of protection against financial loss to the payment service provider than the second of the plurality of debit options ([0057]).

Claim 12 is being rejected using the same rationale as claim 1.

Claim 13 is being rejected using the same rationale as claim 2.

Claim 14 is being rejected using the same rationale as claim 3.

Claim 15 is being rejected using the same rationale as claim 4.

Claim 18 is being rejected using the same rationale as claim 7.

Claim 19 is being rejected using the same rationale as claim 8.

Claims 20-21 are being rejected using the same rationale as claim 1.

Claim 22 is being rejected using the same rationale as claim 11.

Regarding claim 23, Cataline discloses the method of claim 1. Cataline further discloses wherein determining a credit option associated with the one of the plurality of debit options including selecting one credit option form a plurality of credit options ([0021]).

Claim 25 is being rejected using the same rationale as claim 23.

Regarding claim 27, Cataline discloses the method of claim 1. Cataline further discloses wherein each processing factor of the plurality of processing factors has a factor value, wherein the evaluation of each debit option of the plurality of debit options based on the at least one processing factor includes evaluating the respective factor value for the at least one processing factor associated with each debit option, and wherein the selection of one of the plurality of debit options is based, at least in part, on the evaluation of the respective value for the at least one of processing factor plurality associated with each debit option ([0024] to [0026]).

Claim 28 is being rejected using the same rationale as claim 27.

CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MOHAMMAD Z. SHAIKH whose telephone number is (571)270-3444. The examiner can normally be reached on Monday-Friday (7:30-5); alt Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Z. S./
Examiner, Art Unit 3696
4/9/2009

Mohammad Z Shaikh
Examiner
Art Unit 3696

/Daniel S Felten/

Primary Examiner, Art Unit 3696